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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/955,080	09/19/2001	Kenji Yamaguchi	213672US2	9701
22850	7590	12/02/2003	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			PIZARRO CRESPO, MARCOS D	
			ART UNIT	PAPER NUMBER
			2814	

DATE MAILED: 12/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/955,080	KENJI YAMAGUCHI, ET AL.	
	Examiner	Art Unit	
	Marcos D. Pizarro-Crespo	2814	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 19 September 2001.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-20 are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

Application/Control Number: 09/955,080 (Restriction)  
Art Unit: 2814

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Attorney's Docket Number: 213672US2

Filing Date: 9/19/2001

Claimed Foreign Priority Date: 5/19/2001 (JP P2001-138712)

Applicant(s): Kenji Yamaguchi, et al.

Examiner: Marcos D. Pizarro-Crespo

### **DETAILED ACTION**

This Office action responds to application ser. no. 09/955,080 filed on 9/19/2001.

#### ***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-5, 12, and 13, drawn to a method of evaluating a semiconductor device, classified in class 438, subclass 17.
  - II. Claims 6 and 14, drawn to a recording medium, classified in class 360, subclass 97.01.
  - III. Claims 7-11, 15, and 16, drawn to an evaluation apparatus, classified in class 324, subclass 769.
  - IV. Claims 17-20, drawn to a manufacturing control method, classified in class 716, subclass 5.

2. The inventions are distinct, each from the other because of the following reasons:

Invention I and II are related as method of evaluation and recording medium to save a program used to carry out the evaluation method. The inventions are distinct if they are disclosed as related, but are capable of separate manufacture, use, or sale, as claimed, and are patentable over each other (MPEP § 802.01). In the instant case,

unpatentability of the group-I invention would not necessarily imply unpatentability of the group-II invention, since the evaluation method of the group-I invention and the recording medium of the group-II invention may have different uses, for example, the recording medium of claim 6 may be used to record a video game program and the evaluation method of claim 1 may be used to control the manufacturing process of semiconductor devices.

Inventions I and III are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process (MPEP § 806.05(e)). In this case, unpatentability of the group-I invention would not necessarily imply unpatentability of the group-III invention since the apparatus of the group-III invention could be used to performed processes materially different than those of the group-I invention, for example, the apparatus of claim 7 may be used to determine and plot the gate capacitance and channel length of a transistor. This step may replace the step recited in claim 12 of determining and plotting the line width and the channel length of a transistor.

Inventions I and IV are related as method of evaluation of a semiconductor device and manufacturing control method of a semiconductor device. The inventions are distinct if they are disclosed as related, but are capable of separate manufacture, use, or sale, as claimed, and are patentable over each other (MPEP § 802.01). In the instant case, unpatentability of the group-I invention does not necessarily imply

unpatentability of the group-IV invention since the evaluation method of the group-I invention and the manufacturing control method of the group-IV invention may have different uses, for example, the evaluation method recited in claim 1 may be used to determine the gate capacitance of a transistor and the control method of claim 20 may be used to reject transistors whose gate resistance fails to conform to required standards.

Inventions II and III are related as recording medium and apparatus reading the information on the recording medium. The inventions are distinct if they are disclosed as related, but are capable of separate manufacture, use, or sale, as claimed, and are patentable over each other (MPEP § 802.01). In the instant case, unpatentability of the group-II invention does not necessarily imply unpatentability of the group-III invention since the recording medium of the group-II invention and the apparatus of the group-III invention may have different uses, for example, the recording medium of claim 6 may be used to store a video game program and the apparatus of claim 7 may be used to determine and plot the line width and the channel length of a transistor.

Inventions II and IV are related as recording medium used to save a program used to carry out a method and method saved. The inventions are distinct if they are disclosed as related but are capable of separate manufacture, use, or sale, as claimed, and are patentable over each other (MPEP § 802.01). In the instant case, unpatentability of the group-II invention does not necessarily imply unpatentability of the group-IV invention since the recording medium of the group-II and the method of the group-IV may have different uses, for example, the recording medium in claim 6 may be

used to store a video game program and the control method of claim 17 may be used to reject semiconductor devices that fail to meet required standards.

Inventions III and IV are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, unpatentability of the group-III invention would not necessarily imply unpatentability of the group-IV invention since the apparatus of the group-III invention could be used to perform processes materially different than those of the group-IV invention, for example, the apparatus of claim 7 may be used to reject products that fail to meet required standards. This step may replace the step recited in claim 17 of reappraising the manufacturing conditions of semiconductor devices.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim

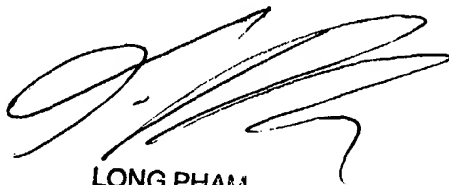
remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Conclusion***

6. Papers related to this application may be submitted directly to Art Unit 2814 by facsimile transmission. Papers should be faxed to Art Unit 2814 via the Art Unit 2814 Fax Center located in Crystal Plaza 4, room 3C23. The faxing of such papers must conform to the notice published in the Official Gazette, 1096 OG 30 (15 November 1989). The Art Unit 2814 Fax Center number is **(703) 308-7722** or **-7724**. The Art Unit 2814 Fax Center is to be used only for papers related to Art Unit 2814 applications.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Marcos D. Pizarro-Crespo** at **(703) 308-6558** and between the hours of 9:30 AM to 8:00 PM (Eastern Standard Time) Monday through Thursday or by e-mail via [Marcos.Pizarro@uspto.gov](mailto:Marcos.Pizarro@uspto.gov). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wael Fahmy, can be reached on (703) 308-4918.

8. Any inquiry of a general nature or relating to the status of this application should be directed to the **Group 2800 Receptionist** at **(703) 308-0956**.



**LONG PHAM**  
**PRIMARY EXAMINER**

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